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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,258	05/29/2001	Ivan Gout	040750-5002	2842

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EXAMINER
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RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 09/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/762,258

Applicant(s)

GOUT ET AL.

Examiner

Delia M. Ramirez

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56, 58-66 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) 74-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56 and 68-73 is/are rejected.
- 7) ☒ Claim(s) 58-66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Status of the Application***

Claims 56, 58-66, 68-78 are pending.

Applicant's amendment of claims 56, 58, 68, 69, 70, and cancellation of claims 57, 67 in Paper No. 12, filed on 8/20/2003 is acknowledged.

Upon further consideration, the finality of the previous Office Action Paper No. 11, mailed on 5/20/2003 is hereby withdrawn due to new ground(s) of rejection not previously introduced.

Claims 74-78 remain withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to an invention non-elected without traverse in Paper No. 9, filed 6/21/01.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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1. Claims 56, 68-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandman et al. (U.S. Patent No. 6156523, effective filing date 11/15/1996). Bandman et al. teaches a polynucleotide encoding a serine/threonine protein kinase which is 93.7% sequence identical to the open reading frame of SEQ ID NO: 1. See attached alignment. The open reading frame of SEQ ID NO: 1 consists of nucleotides 77 through 1561 (1485 nucleotides). An alignment of the polynucleotide of Bandman et al. and the polynucleotide of SEQ ID NO: 1 shows that the polynucleotide of Bandman et al. is missing nucleotides 77-88 of SEQ ID NO: 1 (12 nucleotides), and has 81 mismatches within nucleotides 89-1561 of SEQ ID NO: 1 (including gaps). As such, the polynucleotide of Bandman et al. has a total of 1392 matches ( $1392 = 1485 - 12 - 81$ ) over the open reading frame of SEQ ID NO: 1 and is 93.7% ( $1392 \times 100 / 1485$ ) sequence identical to the polynucleotide of SEQ ID NO: 1 within nucleotides 77-1561 of SEQ ID NO: 1. Since claim 56 is directed to a polynucleotide having at least 85% sequence identity to the open reading frame set forth in SEQ ID NO: 1, the polynucleotide of Bandman et al. anticipates claim 56 as written. Bandman et al. also teaches the use of promoters operably linked to the polynucleotide (column 15, lines 23-49), vectors comprising the polynucleotide (column 15, lines 23-49), host cells comprising said vectors (column 15, line 60-column 17, line 4), and methods of recombinantly producing the polypeptide encoded by the polynucleotide (column 15, line 23, column 18, line 45). Since claims 68-73 are directed to the polynucleotide of claim 56 further comprising an operably linked promoter, a vector comprising the polynucleotide of claim 56, a host cell comprising said vector or said polynucleotide, and a method to recombinantly produce the polypeptide encoded by the polynucleotide of claim 56, the teachings of Bandman et al. anticipate the claims as written.

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*Allowable Subject Matter*

2. Claims 58-66 appear to be allowable over the prior art of record but are objected to because they depend upon a rejected claim.

*Conclusion*

3. It is noted that if the references cited by the Examiner are too long, only relevant pages will be enclosed with the instant Action.


4. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.  
Patent Examiner  
Art Unit 1652

DR  
September 15, 2003

  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
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1620